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OFFICE OF PETITIONS

In re Application of :
Radu and Dry : DECISION ON PETITION AND
Application No. 10/711,587 : DECISION REFUSING STATUS
Filed: 27 September, 2004 : UNDER 37 CFR 1.47(a)
Atty Docket No.
05116 (LC 0171 PUS) :

This is in response to the petitions under 37 CFR 1.137(b)¹ and 37 CFR 1.47(a) on filed on 6 September, 2005.

The petitions are **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

¹ Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The application became abandoned on 21 December, 2004, for failure to timely file a reply to the Notice to File Missing Parts of Nonprovisional Application mailed on 20 October, 2004, which required an executed oath or declaration and a surcharge for its late filing. The Notice set a two (2) month shortened period for reply. No extensions of time in accordance with 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on 6 July, 2005.

On 6 September, 2005, the present petition under 37 CFR 1.137(b) was filed, along with a declaration naming Bogdan Radu and Alan George William Dry as joint inventors and signed by joint inventor Dry, and a petition under 37 CFR 1.47(a).

Petition Under 37 CFR 1.47(a)

Petitioners assert that a copy of the application and declaration were sent to joint inventor Radu, but that Radu has failed to sign and return the declaration naming him as a joint inventor along with joint inventor Dry. Petitioners have further provided a copy of a cover letter transmitting the declaration and a power of attorney to Radu, dated 7 January, 2005, as well as an E-mail from Jo Anne Croskey, assistant to registered patent attorney Jeffrey J. Chapp, transmitting the declaration and assignment to Radu.

It is noted that a grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1).

With regard to item (1), petitioners have not provided proof that the non-signing inventor was ever sent or presented with a copy of the application as filed (specification, including claims, drawings, if any, and the declaration).² Specifically, although it is noted that the petition states that on 8 September, 2004, inventor Radu "received a copy of the subject patent application and was informed that a declaration would need to be signed by all inventors" it is unclear whether the statement was made by an individual with first-hand knowledge.

Petitioners may show proof that a copy of the application was sent or given to the non-signing inventor for review by providing a copy of the cover letter transmitting the application papers (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners must show that a copy of the application was sent or given to the inventor. If the inventor refuses in writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

If the envelope sent to the non-signing inventor at the last known address is returned as undeliverable by the post office, petitioners should provide a copy of the envelope showing that the application was returned as undeliverable with any renewed petition. If the inventor refuses in writing to sign, a copy of that written refusal should be provided with any renewed petition. If the inventor refuses orally, petitioners should submit details of the refusal in an affidavit or declaration of facts by a person having first-hand knowledge of the refusal.

If repeated attempts to contact the non-signing inventor are unsuccessful, petitioners will have shown that despite diligent efforts, the inventor could not be reached.

The petition fee of \$200.00 and surcharge of \$130.00 will be charged to counsel's deposit account, No. 50-0476, as authorized on the fee transmittal sheet filed with the present petitions.

Petition Under 37 CFR 1.137(b).

² MPEP 409.03(d).

Since the petition under 37 CFR 1.47(a) is not grantable, petitioners have not submitted the reply required by the Notice to File Missing Parts mailed on 20 October, 2004. Therefore, action on the petition under 37 CFR 1.137(b) will be held in abeyance until after the requirements for a grantable petition under 37 CFR 1.47(a) have been met.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Mail Stop Petition
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.



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